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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,866

04/13/2004

Hiroko Tsukamoto

T36-165693M/RS

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EXAMINER

SANEI, HANA ASMAT

ART UNIT

PAPER NUMBER

2879

MAIL DATE

DELIVERY MODE

01/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/822,866	Applicant(s) TSUKAMOTO ET AL.	
	Examiner Hana A. Sanei	Art Unit 2879	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07, December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Response to Arguments Correspondence.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____

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Response to Arguments

Applicant's arguments filed on 12/7/06 have been fully considered but they are not persuasive.

In response to Applicant's arguments that Ishibashi (JP 2001196641 A) in view of Susumu et al (JP 08-330637) in further view of Okazaki (US 2002/0024299) does not make a prima facie case of obviousness, the Examiner respectfully disagrees.

Firstly, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

Secondly, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Thirdly, in response to applicant's argument that the Ishibashi's "Surface mount semiconductor device with a **light emitting element 4**," Susumu's "Surface-mount **light-emitting diode**," and Okazaki's "Chip-type **light-emitting device**" is

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nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. Furthermore, all three references are clearly drawn to an LED. That there is a question of the three devices being analogous is unclear, since the **embodiments are drawn to the same type of device.**

Fourthly, the language employed to describe the Applicant's invention does indeed read upon the teachings of the previous Office Action. The exposed surface, 7, of Ishibashi is still present after modifying the device to include the improvements of Susumu. Examiner in no way undermines the purpose and importance of the exposed surface, 7. This is ensured because the resist 7 (hereinafter referred to as 7') of Susumu is formed **only** at the "junction point," therefore 7' would consequently cease at the point where the exposed surface, 7, of Ishibashi is created, thereby maintaining the key invention of Ishibashi while adding the improved benefits of the resist layer of Susumu. Additionally, while the claim language requires the resist layer to be "bonded to a surface of the copper layer," it does not necessarily require that the resist layer be **directly or indirectly** "bonded to a surface of the copper layer. Therefore either/or is applicable. This selection of either/or greatly broadens the scope of proper claim interpretation.

Okazaki teaches a resin frame member (5, reflective case, see at least Fig. 3; [0024]) fixed onto the substrate (4, chip substrate) through an adhesive agent (epoxy adhesive, [0024]) wherein light transmissive resin (7) is packed in the frame of the resin

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frame member; and to form such a structure that the resist (7 of Fig. 1 of '637) is at least partially put between the substrate and the resin frame member in order to ensure a high reflection efficiency of visible light ([0024]). It should be noted that at least a **portion of the frame member** is indeed formed on the resist layer (7 of Fig. 1 of '637) of Ishibashi-Susumu. Furthermore, in the additional manufacturing step Okazaki, the placement of the frame member following the insertion of the resist layer ensures that the frame member is formed on the resist layer. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the resin frame member, as disclosed by Okazaki, in the device of Ishibashi-Susumu in order to ensure high reflection efficiency of visible light. Accordingly, the limitations are disclosed by that Ishibashi-Susumu-Okazaki's teaching, which falls within applicant's claimed invention.

For the reasons stated above, the rejection of the claims is deemed proper.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hana A. Sanei whose telephone number is (571) 272-8654. The examiner can normally be reached on Monday- Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimeshkumar D. Patel can be reached on (571) 272-2457. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Hana A. Sanei
Examiner



Joseph Williams
Primary Examiner